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APPLICATION NO.	FILING DATE		FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/724,569 11/28/2000		11/28/2000	John P. Anderson	015270-006446US	6102	
20350	7590	12/29/2004		EXAMINER		
		TOWNSEND A	WALICKA, MALGORZATA A			
TWO EMBA EIGHTH FL		RO CENTER	ART UNIT	PAPER NUMBER		
		CA 94111-3834	1652			

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)							
	09/724,569	ANDERSON ET AL.							
Office Action Summary	Examiner	Art Unit							
	Malgorzata A. Walicka	1652							
The MAILING DATE of this communication ap	pears on the cover sheet with	the correspondence address							
Period for Reply									
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).									
Status									
1) Responsive to communication(s) filed on 01 L	December 0704.								
2a) This action is FINAL . 2b) ⊠ Thi									
3) Since this application is in condition for allowed									
closed in accordance with the practice under	Ex parte Quayle, 1935 C.D.	11, 453 O.G. 213.							
Disposition of Claims									
4)⊠ Claim(s) <u>56-77</u> is/are pending in the application	on.	*							
4a) Of the above claim(s) 59 and 60 is/are wit	hdrawn from consideration.								
5) Claim(s) is/are allowed.									
6)⊠ Claim(s) <u>56-58 and 61-77</u> is/are rejected.									
7) Claim(s) is/are objected to.									
8) Claim(s) are subject to restriction and/	or election requirement.								
Application Papers		S-X							
9)⊠ The specification is objected to by the Examin	er.								
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.									
Applicant may not request that any objection to the									
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).									
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.									
Priority under 35 U.S.C. § 119	·								
12) Acknowledgment is made of a claim for foreig	n priority under 35 U.S.C. § 1	119(a)-(d) or (f).							
a) ☐ All b) ☐ Some * c) ☐ None of:									
 Certified copies of the priority documer 									
· · · · · · · · · · · · · · · · · · ·	2. Certified copies of the priority documents have been received in Application No								
3. Copies of the certified copies of the priority documents have been received in this National Stage									
application from the International Bureau (PCT Rule 17.2(a)).									
* See the attached detailed Office action for a list of the certified copies not received.									
		i							
Attachment(s)									
1) Notice of References Cited (PTO-892)		mmary (PTO-413)							
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	a. 🗖	Mail Date crmal Patent Application (PTO-152)							
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08 Paper No(s)/Mail Date 12/11/02.	6)								
J.S. Patent and Trademark Office		Part of Paper No /Mail Date 122004							

Continuation of Attachment(s) 6). Other: sequence alignments used in 102 rejections.

The Response to Restriction Requirement filed Dec. 7, 2004, and Supplemental is acknowledged. The Amendments to the claims and specification have been entered as requested. Claims 1-55 and 78-131 are canceled. Claims 56-77 are pending in the application and claims 56-58 and 61-77 are the subject of this Office Action; claims 59-60 as directed to non elected species and are withdrawn from examiner's consideration.

DETAILED ACTION

1. Restriction/election

Applicant's election, without traverse, of Group V, claims 56-77 is acknowledged. In response to requirement of election of species Applicant elected polypeptides having an amino acid sequence starting with amino acid residues No. 46 of SEQ ID NO: 2.

Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Claims 59 and 60 are directed to nucleic acid molecules encoding polypeptides that do not start with the 46th amino acid of SEQ ID NO: 2. Thus these claims do not read on the elected species and are not under current examination.

2. Objections

2.1. Oath

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The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. It was not executed in accordance with either 37 CFR 1.66 or 1.68.

The oath or declaration is defective because: there is lack of date of signature of the inventor McConlogue on page 4 of 4.

2.1. Specification

Description of Fig. 5 on page 8 is objected to, because it is confusing about the term proenzyme. The description states that SEQ ID NO: 43 is "the proenzyme region corresponding to amino acids 46-501", whereas in the same description Applicant write that the putative pro- region consists of residues 22-45; SEQ ID NO: 47. Thus residues 46-501 represent the mature enzyme and not proenzyme. Please correct the description of Fig. 5.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors in the specification of which applicant may become aware.

3. Rejections

3.1. 35 USC, section 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 72-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are rejected as dependent on the canceled claim 55. The claims cannot be examined.

3.2. 35 USC, section 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

- 1. A person shall be entitled to a patent unless –
- (b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 56-58 and 61-68 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent No. 6,319,689, issued to Powell et al. on Nov. 20, 2001, with priority date Jan. 28, 1997.

The claims are directed:

claim 56-58 to an isolated nucleic acid, <u>comprising</u> a sequence of nucleotides that encode a beta-secretase that is at least 95% identical to a

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protein selected from the group consisting of SEQ ID NO: 43, 58 and 71, or a complementary sequence specifically excluding a nucleic acid encoding a protein having the sequence SEQ ID NO: 2;

claims 61-67

to an expression vector and heterologous cells transfected with nucleic acid of claim 56;

claims 68

to recombinant production of beta secretase encoded by nucleic acid of claim 56 and purification of the produced protein on an affinity matrix.

Powell discloses the full amino acid sequence, i.e., 501 amino acids, of human beta-secretase that differs from the full amino acid sequence of the instant invention in residue 130, i.e. Powell et al.'s sequence has glutamic acid in that position and SEQ ID NO: 2 of the instant invention has in that position valine. In the patent the sequence is also identified by SEQ ID NO: 2. SEQ ID NO: 43, 58 and 71 of the instant application are more than 99% identical to the fragments of beta secretase of SEQ ID NO: 2 of the patent, wherein said fragments consist of amino acids 46-501, 46-452 and 46-419 of SEQ SEQ ID NO: 2 of the patent. Powell discloses nucleic acid molecule of SEQ ID NO: 1 encoding beta-secretase of SEQ ID NO: 2, thus Powell at al. disclose nucleic acid molecules having limitations recited in claims 56-58; see the alignment of SEQ ID NO: 43 and 42 with that of Powell's. Powell et al. teach also expression vectors, host cells and recombinant production of beta-secretase; see column 14, subtitle Vectors,

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Host Cells Expression. In column 15, line 10 Powell et al. teach purification of the expressed enzyme using, among others, affinity chromatography.

Furthermore the following rejection over prior art is applicable.

2. A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

In addition to rejection over Powell and al.'s patent, claims 56-58, 61-69 and 71 are rejected under 35 U.S.C. 102(g) as being anticipated by US patent No. 6, 420, 534, issued to Gurney et al. on July 16, 2002, with priority date September 24, 1998.

Gurney discloses the full amino acid sequence, i.e., 501 amino acids, of mouse beta-secretase identified by SEQ ID NO: 8, which is 98.8% identical to SEQ ID NO: 43 of the instant application; see the enclosed sequence alignment of the amino acid and

nucleotide sequences. Gurney et all teach vectors, host cells and expression of the disclosed sequences in several cell systems; see columns 23-25 and examples 9, 10 and 11 of the patent. The patent teaches also several methods of purification of the beta-secretase, including affinity chromatography using polyclonal and monoclonal antibodies; see column 23, first paragraph. Thus, Gurney et al. teach all the limitations of claims 56-58, 61-69 and 71.

4. Conclusion

All claims are rejected. No claim is in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malgorzata A. Walicka whose telephone number is (571) 272-0944. The examiner can normally be reached on Monday-Friday from 10:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Malgorzata A. Walicka, Ph.D.

Art Unit 1652

Patent Examiner

REBECCA E. PROUTY
PRIMARY EXAMINER
OROUP 1880

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Pred. No. 4.8e-251;
0; Mismatches 1;
CALPMLPLCLMVCQWRCLRCLRQQHDDFADDISLLK 456
                                                                                                                                                                                                                                                                                                                                                                                                    COMPUTER READBLE FORM:
MEDIUM TYPE: Diskette
COMPUTER: IBM Compatible
OPERATING SYSTEM: DOS
SOFTWARE: FESTEED for Windows Version
CURRENT APPLICATION DATA:
FILING DATE: 20-JAN-1998
                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                            CLASSIFICATION:
PRIOR APPLICATION DATA:
APPLICATION NUMBER: UK 9701684.4
--EILLMG-DATE: 28-JAN.1997
ATTORNEY/AGENT INFORMATION:
NAME: PRESTIA, PAUL F
REGISTRATION NUMBER: G1-70368
TELEPHONE: 610-407-0701
TELEPHONE: 610-407-0701
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                                                                                RESULT 3
US-09-009-191-2
Sequence 2, Application US/09009191
Sequence 2, Application US/09009191
GENERAL INFORMATION:
APPLICANT: CHAPMAN. CONRAD
APPLICANT: CHAPMAN. CONRAD
APPLICANT: MURPHY, KAY
APPLICANT: MURPHY, KAY
CONRESPONDENCES: 6
CORRESPONDENCES: 6
STREET: P.O. BOX 980
CITY: VALLEY FORCE
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TELEFAX: 610
TELES: 846169
INFORMATION FOR SEQ ID NO: 2:
SEQUENCE CHARACTERISTICS:
LENGTH: 501 amino acids
"VDE: amino acid
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Sequence 4. Application US/09548367D
GENERAL INFORMATION:
APPLICANT: GURNEY ET AL.
TITLE OF INVENTION: ALZHEIMER'S DISEASE SECRETASE, APP SUBSTRATES THEREFOR AND USES:
TITLE OF INVENTION: ALZHEIMER'S DISEASE SECRETASE, APP SUBSTRATES THEREFOR AND USES:
TITLE OF INVENTION: ATHEREOF
TITLE OF INVENTION: AUGUST 129915/52001
CURRENT APPLICATION NUMBER: US 60/155,493
PRIOR FILING DATE: 1999-09-23
PRIOR FILING DATE: 1999-09-23
PRIOR APPLICATION NUMBER: US 60/101,594
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PRIOR APPLICATION NUMBER: US 60/101,594
PRIOR FILING DATE: 1998-09-23
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SOFTWARE: PALEGATION NUMBER: US 60/101,594
PRIOR FILING DATE: 1998-09-23
SOFTWARE: PALEGATION NUMBER: US 60/101,594
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PRIOR FILING DATE: 1998-09-24
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0; Mismatches 0;
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APPLICANT: 210, XIAOTONG
APPLICANT: L1, XIAOTONG
APPLICANT: CHILL DAVID J.
TITLE OF INVENTION: MOUSE ASPARTIC SECRETASE-2 (MASP-2)
FILE REFERENCE: GP-70660
CURRENT FRING DATE: 2000-11-15
PRIOR FILING DATE: 2000-11-16
NUMBER OF SEQ ID NOS: 2
SOFTWARE: FASTESEO FOR WINDOWS VERSION 3.0
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1.5e-248;
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                                                                                                                                            421 CALFMLPLCLMVCOWRCLRCLRQQHDDFADDISLLK 456
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Pred. No. 1.5e
4; Mismatches
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S-09-713-158-2
Sequence 2, Application US/09713158
Patent No. 6361975
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Matches 448; Conservative
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US-09-713-158-2
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LENGTH: 501
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GENERAL NO. VAINSAT

GENERAL NECRMATION:
APPLICANT: GURNEY ET AL.
TITLE OF INVENTION: ALTHEIMER'S DISEASE SECRETASE, APP SUBSTRATES THEREFOR AND TITLE OF INVENTION: THEREOF.
TITLE OF INVENTION: ALTHEIMER'S DISEASE SECRETASE, APP SUBSTRATES THEREFOR AND TITLE OF INVENTION: ALLANGE OF STATES OF STATES OF STATES OF STATES.
FILE REFERENCE: 29915/62801
CURRENT APPLICATION NUMBER: US 60/155.493
PRIOR PILLING DATE: 1999-09-23
PRIOR PILLING DATE: 1999-09-23
PRIOR PILLING DATE: 1999-09-23
PRIOR PILLING DATE: 1999-09-24
NUMBER OF SEQ ID NOS: 73
SOFTWARE: PATENTIN VORTER: 1998-09-24
NUMBER OF SEQ ID NOS: 73
SOFTWARE: PATENTIN VORTERION 3.1
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Pred. No. 1.5e-248;
4; Mismatches 4;
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5-09-548-372D-8
Sequence 8, Application US/09548372D
Patent No. 6420534
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1) 98.29
Conservative
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Matches 448; Conserv
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APPLICANT: GURNEY ET

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1497 ATCATGGAGGCTTCTACGTGTCTTTGATCGGGCCCGAAAACGAATTGGCTTTTGTTCTTT	Db 1141 TTGGACATGGAAGACTGTGGCTACAACATTCCACAGACAG	Db 1261 TGTCAGTGGCCCTCCCTGCCCGCCAACAATGATTGCTGATGACTTT 1320	09 1916 AGGACCTCCCCACCAAATGCCTTGATGCAGAAGGAAAAGGCTGGCAAGG 1975	Oy 2036 CGGGAATACTCTTGGTCACCTCAAATTTAAGTCGGGAATTCTGCTGCTTGAAACTTCAG 2095	2156 AGTTTCAGAAGTACTGGCATCACGCAGGTTACCTTGGCGTGTGTCCTTGTGGTACCT 221 1681 AGTTTCAGAAGTACTGGCATCACGCAGGTTACCTTGGCGTGTGTCCCTGTGGTACCT 1681 AGTTTCAGAAGTACTGGCATCACGCAGGTTACCTTGGCGTGTGTGT	0y 2276 GTTTCTATTTCCTTTAGAGAGAGGATGTATAACAACCTACAATGGGGAAGT 2335 1111111111111111111111111111111111	RESULT 7 US-09-548-372D-7 US-09-548-37.2D-7 Sequence 7. Application US/09548372D Fatent No. 6420534 GENERAL INFORMATION: A PAPLICANT: GURNEY ET AL. TITLE OF INVENTION: THEREOF FILE REFERENCE: 29915/62801 CURRENT FILICATION NUMBER: US/09/548,372D CURRENT FILING DATE: 2000-04-12 FRIOR APPLICATION NUMBER: US 60/155,493
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Ouery Match Best Local Similarity 99.1%; Score 1835.4; DB 4; Length 2370; Best Local Similarity 99.1%; Pred. No. 0; Matches 1856; Conservative 0; Mismatches 16; Indels 1; Gaps Oy 477 GGCAGCTTTGTGGAGATGGTGACAACCTGAGGGCAAGTGGGGGCAGGGCTACTACGTG 53 Db 1 GGCAGCTTTGTGGAGATGGTGGACAACCTGAGGGGCAAGTCGGGGCAGGCTACTACGTG 60 Oy 537 GAGATGACGGTGGAGACCCCCCCAACAACATCCTGGTGGATACAGGCAGCT 59		11 IIIIIIIIIIIIIIIIIIIIIIIIIIIIIIIIIII	937 GGCANCATION CANCERTORATION CONCERNOS CONTROLLAND C	CTGCAGCTTTGTGGT 4 SGGAGCATGATCATT 1 SGGAGCATGATCATT 5 CCCATCGGCGGGAG 1 CCCATCGGCGGGAG 1 CCCATCGGCGGGAG 1 CCCATCGGCGGGAG 1	1077 TGGTATTATGAGGTGATCATTGTGCGGGTGGAGATCAATGGACAGGATCTGAAAATGGAC 1 1 1 1 1 1 1 1 1 1	Qy 1197 CCCAAGAAAGTGTTTGAAGCTGCAGTCAAATCCATCAAGGCAGCCTCCTCCACGGAGAG 12	Oy 1317 TGGAACATTTTCCCAGTCATCACTCTAATGGGTGAGGTTACCAACCA
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87.9%; Pred. No. 0;
tive 0; Mismatches 235;
PRIOR FILING DATE: 1999-09-23
PRIOR APPLICATION NUMBER: US 09/404,133
PRIOR PTLING DATE: 1999-09-23
PRIOR FILING DATE: 1999-09-23
PRIOR FILING DATE: 1999-09-23
PRIOR FILING DATE: 1999-09-23
PRIOR FILING DATE: 1996-09-24
NUMBER OF SEQ ID NOS: 73
SCOFWARE: PRECRILIN VERSION 3.1
SEQ 10 NO
                                                                                                                                      Conservative
                                                                                       ; TYPE: DNA
; ORGANISM: Mus musculus
US-09-548-372D-7
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Matches 1794;
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      Indels 13;
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                                                                                                                           TITLE OF INVENTION: ALZHEIMER'S DISEASE SECRETASE, APP SUBSTITLE OF INVENTION: THEREOF: TITLE OF INVENTION: THEREOF: TITLE OF INVENTION: THEREOF: TITLE OF INVENTION: THEREOF: SILE REFERENCE: 29915/6280H
CURRENT APPLICATION NUMBER: US/09/548,367D
CURRENT FILING DATE: 1999-09-13
PRIOR PELICATION NUMBER: US 00/404,133
PRIOR FILING DATE: 1999-09-23
PRIOR FILING DATE: 1999-09-23
PRIOR FILING DATE: 1999-09-23
PRIOR FILING DATE: 1999-09-23
PRIOR FILING DATE: 1999-09-24
PRIOR FILING DATE: 1999-09-24
STOR FILING DATE: 1998-09-24
NUMBER OF SEQ ID NOS: 73
SEQ ID NO 700
                                                                                                                                                                                                                                                                                Score 1550; DB 4;
Pred. No. 0;
0; Mismatches 235;
                                                                                                         Sequence 7, Application US/09548367D Patent No. 6440698 GENERAL INFORMATION:
                                                                                                                                                                                                                                                                               Query Match 66.0%;
Best Local Similarity 87.9%;
Matches 1794; Conservative
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